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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,392

11/03/2003

Kazuo Hiraguchi

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

GREENHUT, CHARLES N

ART UNIT

PAPER NUMBER

3652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,392	<b>Applicant(s)</b> HIRAGUCHI ET AL.	
	<b>Examiner</b> Charles N. Greenhut	<b>Art Unit</b> 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**I. Request for Continued Examination**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/06 has been entered.

**II. Claim Objections**

1. Claim 8 Line 15: "the same as a first pair" should read, - - the same as an interval between a first pair - -

**III. Claim Rejections - 35 USC § 112**

The following is a quotation from the relevant paragraphs of 35 U.S.C. 112:

(2) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1.1. With respect to claim(s) 1 and 8, and those claims repeating the term "grasped portions", Applicant recites in the clarified preamble, and the remarks entered 12/20/06, that the intended claim combination is that of the structure for holding the cartridges and the two cartridges themselves. This is interpreted to mean that Applicant does not intend any portion of the portion of the grasping device (e.g., 70/80) to be a required element of the claimed combination. Referring to the concave portions of the tape cartridges as "grasped" would imply that a grasping structure is

required element the claim, which is apparently not the case. If the grasping device is not an intended element of the claimed combination the description of the grasped portions should be revised to, e.g., graspable portions, or a similar term.

- 1.2. With respect to claim(s) 1 and 8, Applicant recites the phrase, "grasped portions of the first recording tape cartridge at a removal side of the library" in lines 18-19. Firstly, this amounts to an indirect limitation of the grasped portions, since the grasped portions were never previously set forth as being at a removal side of the library, which, therefore, lacks antecedent basis. Secondly, this phrase defines a component of the claimed combination, "grasped portions of the first recording tape cartridge" in terms of the library, which has only been previously set forth functionally. I.e., The preamble "A combination of a structure for holding recording tape cartridges in a same library and a first..." along with the remarks entered 12/20/06 indicate Applicant's intent to claim the structure for holding, e.g., the accommodation chamber (112)/(102), in combination with the cartridges and not necessarily the library. The limitation requiring the grasped portions to be at a removal side of the library would require the library itself to be a claimed element. Since this is contradictory to Applicant's preamble and remarks, the limitation renders the scope of the claim indefinite because it is unclear whether the claimed combination requires a library as an element thereof. Note: the phrase is repeated again in claim 1 with respect to the second cartridge (Li. 20).

- 1.2(a) The same issue is present in claim 8 with respect to the phrases, "near a removal opening of the library" and "in the accommodating chamber of the library" in lines 15 and 21 respectively.
- 1.3. With respect to claim(s) 2 and 9, Applicant refers to "the side walls" in line 4, however, two side walls have been previously set forth, e.g., claim 1 recites side walls of the case. Subsequent references to the side walls should identify whether Applicant is referring to the side walls of the case or side walls of the grasped portions. Additionally, the side walls of the grasped portions are defined as being continuous from rear surfaces of the concave portions, but there is no indication where they are continuous to. Generally, continuity is defined between a start and an end location. For purposes of examination on the merits Examiner assumes Applicant is referring to side walls (e.g., 66), which extend rearward from the rear of the concave portion.
- 1.4. With respect to claims 6 and 13, a feature of the cassettes, the depth of the concave portions, is defined in terms of the length of the claw portions of the grasping device however, the grasping device is only functionally recited. This phraseology renders the scope of the claim indefinite because it is unclear whether the claimed combination requires a grasping device and/or claws as elements thereof.

#### **IV. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim(s) 1, 3, 8, and 10 is/are rejected under 35 U.S.C. 102(b) as being anticipated by STAAR (US 3,864,743 A).

1.1. With respect to claim(s) 1, 3, 8, and 10 STAAR discloses an accommodation chamber (8), which accommodates both a first (3) and second (21) recording tape cartridge, the first recording tape cartridge (3) being structurally different (cf. Fig. 1-2) that the second (21), the first (3) and second (21) recording tape cartridge each comprising a case (3)/(21) rotatably accommodating a reel (4)/(23) around which a recording tape (2)/(25) is wound, grasped portions (unlabeled proximate arrows in Fig. 1-2), which include concave portions provide at side walls and which a grasping device can grasp from both sides, wherein the height from the floor surface of the accommodating chamber (8) to the grasped portions of the first cartridge (3) at a time when the first cartridge (3) is accommodated in the chamber (8) is the same as the height from the floor surface of the accommodating chamber (8) to the grasped portions of the second cartridge (21) at a time when the second cartridge (21) is accommodated in the chamber (8) (Col. 2 Li. 17-20), and an interval between corner portions of the grasped portions of the first cartridge (3) at a removal side is the same as an interval between corner portions of the grasped portions of the second recording tape cartridge (21) at the removal side (Col. 2 Li. 17-20), and corner portions of the grasped portions of the first recording tape cartridge (3) are chamfered/inclined walls providing guide surfaces (note curved/smoothed transition).

**V. Allowable Subject Matter**

Art Unit: 3652

1. Claim(s) 2, 4-7, 9 and 11-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

1.1. With respect to claims 2 and 9 the following is a statement of reasons for the indication of allowable subject matter

1.1(a) While the prior art of STAAR, TODOR and KAPPEL and that shown by Applicant in Fig. 8 teach recording tape cartridges graspable from the rear at a concave section, a cartridge having the unique feature of an overhang portion hung over a side wall extending rearwardly from the concave portions as described in the language of claims 2 and 9 is not taught or fairly suggested by the prior art.

#### **VI. Response to Applicant's Arguments**

Applicant's arguments entered 6/20/06 have been fully considered but are not persuasive.

1. Applicant argues that SMITH does not anticipate claims 1 and 8, as amended, because SMITH fails to disclose a structure which holds a first recording tape cartridge and a second structurally different cartridge or method for providing such a structure. This argument is persuasive. The rejection under 35 USC 102(b) over SMITH has therefore been withdrawn. Upon further consideration however, a new grounds for rejection is presented above.

#### **VII. Conclusion**

1. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Art Unit: 3652

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Greenhut whose telephone number is (571) 272-1517. The examiner can normally be reached on 7:30am - 4:00pm EST.
3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached at (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.
4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CG

  
PATRICK MACKEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600